

## REMARKS

In the above-identified Office Action the examiner rejected claims 1, 6, and 8 (Note: Claim 8 was cancelled in Paper No. 6) under 35 USC 102(b) as anticipated by US Patent No. 4,950,525 to Bailey ("Bailey"). The examiner rejected claims 2-5 under 35 USC 102(b) as anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over Bailey. The examiner rejected claim 1 under 35 USC 103(a) as being unpatentable over US Patent No. 5,977,263 to Phillips ("Phillips") or US Patent No. 5,882,771 to Klein, et al. ("Klein") in view of Bailey. The examiner rejected claims 1-6 under 35 USC 103(a) as being unpatentable over Phillips in view of Bailey. The examiner rejected claims 1-6 under 35 USC 103(a) as being unpatentable over Klein in view of Bailey. The examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Phillips in view of Bailey and further in view of US Patent No. 5,941,655 to Jacobs et al. ("Jacobs"). The examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Klein in view of Bailey and further in view of Jacobs. And the examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Bailey in view of Jacobs.

Applicant respectfully requests the examiner to enter his amendment to claim 1, which was not entered earlier because the examiner's detailed exposition of the grounds for rejection in Paper No. 7 first served to materially clarify the issues at hand. Applicant further submits that entry of his amendment serves to place the claims in order for allowance or, alternatively, to place the claims in better form for appeal.

### REJECTION OF CLAIMS 1 AND 6 UNDER 35 USC 102(b)

The examiner rejected claims 1 and 6 under 35 USC 102(b) as anticipated by Bailey. Applicant respectfully submits that claim 1 (as amended) and claim 6, which depends from it, are not anticipated by Bailey because Bailey's required additional structure is not encompassed by

applicant's claims which now read on a first coating in essence applied directly to a road surface. Applicant respectfully submits that his claim 1 (as amended) and claim 6, from which it depends, are not anticipated by Bailey and urges the examiner to withdraw this rejection.

#### REJECTION OF CLAIMS 2-5 UNDER 35 USC 102(b) OR 35 USC 103(a)

The examiner rejected claims 2-5 under 35 USC 102(b) as anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over Bailey. As to the rejection over 35 USC 102(b) the examiner presumes that the limitations of claims 2-5 are inherent in the composite of claim 1 and that claim 1 is anticipated by Bailey. Applicant traverses on the basis that claim 1 (as amended) is not anticipated by Bailey as argued above and reserves the right to traverse the inherency argument. Therefore, applicant respectfully submits that claims 2-5 are not anticipated by Bailey and urges the examiner to withdraw this rejection.

. As to the rejection over 35 USC 103(a) applicant respectfully submits that Bailey does not teach or suggest a modification to his structure and that the examiner has not met her burden to point to a clear and particular teaching within Bailey to do so. Applicant respectfully submits that there is no motivation within Bailey to delete a required part of his structure. Therefore, applicant respectfully submits that claims 2-5 are not obvious over Bailey and urges the examiner to withdraw this rejection.

#### REJECTION OF CLAIM 1 UNDER USC 103(a)

The examiner rejected claim 1 under 35 USC 103(a) as being unpatentable over Phillips or Klein in view of Bailey. Applicant respectfully traverses because Phillips teaches a graphic article and Klein teaches sheeting while Bailey does not disclose application of his sheeting directly to a road surface as required by claim 1 (as amended).

The Examiner asserts that applicant's invention is obvious, because one of ordinary skill in the art reading Phillips or Klein in combination with Bailey would know to apply the Phillips' graphic article, or Klein's sheeting to a road surface. Applicant respectfully traverses because Bailey does not teach or suggest application of his sheeting directly to a road surface. Rather, he teaches away from such direct application by disclosing the application of his sheeting to a base plate which is then adhered to a paved surface. Thus, if one skilled in the art were to read Phillips or Klein in combination with Bailey, one would not be motivated to provide a composite having a first coating directly upon a road surface and a clear coating disposed thereon, which are required elements of applicant's invention as defined by claim 1, as amended. Therefore, applicant respectfully submits that claim 1, as amended, is not obvious over Phillips or Klein in view of Bailey and urges the examiner to withdraw this rejection.

#### REJECTION OF CLAIMS 1-6 UNDER 35 USC 103(a)

The examiner rejected claims 1-6 under 35 USC 103(a) as being unpatentable over Phillips in view of Bailey. The examiner has identified elements of applicant's composite within the references, but has not pointed to the reason for combining them. "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular"" *Winner International Royalty Corporation v. Wang*, 202 F.3d 1340 quoting *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

Even if, *arguendo*, one were to combine Phillips and Bailey, applicant's invention of claims 1-6 would not result. The examiner states that Phillips discloses a graphic article including "a binder layer with a pigment layer, a layer of glass microspheres, and a transparent cover film" and "Bailey discloses a retroreflective sheeting used as a marker on the pavement" (Paper No. 7, paragraph 11). Applicant traverses on the basis that Phillips actually

discloses a binder layer with a printed layer thereon, not a single pigmented first layer and because Bailey does not disclose a composite structure having a first coating directly on a road surface. Applicant respectfully submits that there is no teaching or suggestion in Phillips or Bailey to modify their individual structures nor does either provide motivation to combine the two references to provide applicant's composite. Therefore, applicant respectfully submits that claims 1-6, as amended, are not obvious over Phillips in view of Bailey and urges the examiner to withdraw this rejection.

#### REJECTION OF CLAIMS 1-6 UNDER 35 USC 103(a)

The examiner rejected claims 1-6 under 35 USC 103(a) as being unpatentable over Klein in view of Bailey. The examiner has identified elements of applicant's composite within the references, but has not pointed to the reason for combining them. "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular"" *Winner International Royalty Corporation v. Wang*, 202 F.3d 1340 quoting *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

Even if, *arguendo*, one were to combine Klein and Bailey, applicant's invention of claims 1-6 would not result. The examiner states that Klein discloses a retroreflective sheeting having six layers and "Bailey discloses a retroreflective sheeting used as a marker on the pavement" (Paper No. 7, paragraph 12). Applicant traverses on the basis that Klein does not teach or suggest applicant's composite as claimed and because Bailey does not disclose a composite structure directly on a road surface. Applicant respectfully submits that there is no teaching or suggestion in Klein or Bailey to modify their individual structures nor does either provide motivation to combine the two references to provide applicant's composite. Therefore, applicant respectfully submits that claims 1-6, as amended, are not obvious over Klein in view of Bailey and urges the examiner to withdraw this rejection.

#### REJECTION OF CLAIM 7 UNDER 103(a)

The examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Phillips in view of Bailey and further in view of Jacobs. The examiner argues that Phillips and Bailey disclose all limitations of the invention except for the composite including an absorber such as talc and Jacobs discloses a retroreflective article comprising a base sheet including talc. Applicant respectfully traverses on the basis that Phillips and Bailey fail to disclose all limitations of the invention as claimed. Claim 7 which depends from claim 1, as amended, excludes a composite wherein the first coating is not applied directly to the road surface. Nor has the examiner identified the disclosures in Phillips, Bailey, or Jacobs which would motivate one skilled in the art to make the combination. Therefore, applicant respectfully submits that claim 7 is not obvious over Phillips in view of Bailey and further in view of Jacobs and urges the examiner to withdraw this rejection.

#### REJECTION OF CLAIM 7 UNDER 35 USC 103(a)

The examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Klein in view of Bailey and further in view of Jacobs. The examiner argues that Klein and Bailey disclose all limitations of the invention except for the composite including an absorber such as talc and Jacobs discloses a retroreflective article comprising a base sheet including talc. Applicant respectfully traverses on the basis that Klein and Bailey fail to disclose all limitations of the invention as claimed. Claim 7 which depends from claim 1, as amended, excludes a composite wherein the first coating is not applied directly to the road surface. Nor has the examiner identified the disclosures in Klein, Bailey, or Jacobs which would motivate one skilled in the art to make the combination. Therefore, applicant respectfully submits

that claim 7 is not obvious over Klein in view of Bailey and further in view of Jacobs and urges the examiner to withdraw this rejection.

REJECTION OF CLAIM 7 UNDER 35 USC 103(a)

The examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Bailey in view of Jacobs. The examiner argues that Bailey discloses all limitations of the invention except for the composite including an absorber such as talc and Jacobs discloses a retroreflective article comprising a base sheet including talc. Applicant respectfully traverses on the basis that Bailey fails to disclose all limitations of the invention as claimed. Claim 7 which depends from claim 1, as amended, excludes a composite wherein the first coating is not applied directly to a road surface. Nor has the examiner identified the disclosures in Bailey or Jacobs which would motivate one skilled in the art to make the combination. Therefore, applicant respectfully submits that claim 7 is not obvious over Bailey in view of Jacobs and urges the examiner to withdraw this rejection.

Applicant respectfully requests the examiner to pass their claims 1-7, as amended, to allowance at this time. Applicant's agent is available in order to expedite the allowance of this case at 215-641-7822 or by FAX at 215-619-1918.

Respectfully Submitted,



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Date: April 23, 2003

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### CERTIFICATE OF MAILING

I hereby certify that the following correspondence is being deposited as first class mail with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, DC, 20231 on the date indicated next to my signature below.

Amendment After Final Rejection

DATE: *April 23, 2003* SIGNATURE: *Donald D. Sekula*